

REMARKS

Claims 1-30 are pending in the application. The Examiner's reconsideration of all objections and rejections set forth in the Office Action is respectfully requested based on the above amendments and following remarks.

Oath/Declaration

The Office Action asserts that the Declaration filed on 12/27/01 does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

However, this is incorrect, and the Examiner is respectfully directed to page 1 of the Declaration filed on June 11, 2002, wherein such acknowledgment is clearly stated in the first full paragraph below the application identifying information (filing date, serial No.).

Accordingly, withdrawal of the objection is requested.

Claim Rejections – 35 U.S.C. § 101

Claims 1-15 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Although Applicants respectfully disagree with the rejection, claims 1-15 have been amended and are believed to be directed to statutory subject matter. Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Claims 1-7 and 9-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0046316 to Gergic et al.

At the outset, it should be noted that the identifying information (title, serial no, filing dates, etc) of the published Gergic reference is believed to be erroneous. In fact, the disclosure of

the Gergic reference is believed to be related to the commonly assigned U.S. Patent Application No. 09/544,823 filed on April 6, 2000, entitled “Methods and Systems for Multi-Modal Browsing and Implementation of a Conversational Markup Language”, which was cited in the IDS of the current application. Moreover, as cited in paragraph [001] of “Gergic”, the published application claims priority to U.S. provisional patent application serial No 60/158,777 filed on 10/12/99. Despite the publication error, the publication date of March 6, 2003 appears to be correct and the following arguments will be presented based on such date.

With regard to the anticipation rejections, Applicants respectfully submit that at the very minimum, claims 1, 16, 26 and 27 are not anticipated by Gergic.

For example, with respect to claim 1, Gergic does not specifically disclose an application development tool that comprises a plurality of modality-specific editors for generating one or more modality specific representations of an application, *which comprise means for flagging a component of a modality-specific representation to indicate that the interaction associated with the component is not synchronized across other modality-specific views*, as recited in claim 1. In the Office Action (page 6), without explanation, Examiner relies on page 3, section [0021] and page 7, section [0095] as disclosing the above “flagging” feature. Although the cited sections generally disclose synchronization, there is nothing in the cited sections that disclose the “flagging” feature, much less the flagging feature in connection with application development.

Moreover, with respect to claims 16 and 26, although Gergic discloses on page 47 section [1327] application authoring in general, there is nothing in said section that discloses or suggests, *e.g., displaying the application model with an updated portion of the application model highlighted for user review*, as recited in claims 16 and 26.

Furthermore, with respect to claim 27, Applicants respectfully traverse the rejection. For example, it is respectfully submitted that Examiner's reliance on FIGs. 4, 5A-5B and associated text and page 7, section [0095] as disclosing *merging blocks of the modality-specific models to generate a single representation of an application model*, is misplaced. Indeed, Applicants find nothing in the cited section that remotely discloses the merging step as claimed. To the extent that Examiner disagrees, Applicants request that Examiner *explain with particularity* the basis for such rejection, rather than a mere recitation to the cited section.

For at least the above reasons, claims 1, 16, 26 and 27 are not anticipated by Gergic. Moreover, all pending claims that depend from claims 1, 16 and 27 are believed to be not anticipated by Gergic at least for the same reasons given for respective base claims 1, 16 and 27.

Claim Rejections – 35 U.S.C. § 103

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Gergic in view of U.S. Patent No. 6,609,246 to Guhr.

It is respectfully submitted that the obviousness rejection is legally deficient because under 35 U.S.C. § 103(c), the Gergic reference is not available as prior art against the claimed inventions as a basis for obviousness. More specifically, under amended provision 35 U.S.C. §103(c), commonly assigned applications that are available as prior art only under 35 U.S.C. §102(e), (f) or (g) are no longer applicable as prior art to the claimed invention in an obviousness rejection. In particular, 35 U.S.C. §103(c) was amended to recite:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person.

(Emphasis added). See also 1233 OG 55-56 (April 11, 2000), which describes guidelines to implement amended §103(c).

Here, the provisions of 35 U.S.C. 103(c) are applicable to disqualify the Gergic reference as prior art against the claimed inventions for the following reasons. First, Gergic is available as prior art to the present application *only* under 35 U.S.C. §102(e). Indeed, the Gergic was published on March 6, 2003, which is *after* the effective filing date of Applicant's current application, December 4, 2000. Secondly, Applicant's current application was filed *after* the effective date of November 29, 1999 (i.e., the current application was filed on 12/04/01). Thirdly, for purposes of *common ownership*, the current application and the Gergic patent application were, at the time the invention of the current application was made, owned by the same entity, International Business Machines Corporation.

Therefore, the amended provision 103(c) is applicable and the Gergic reference is disqualified as prior art against the claimed inventions and cannot be used support the current claim rejections under 35 U.S.C. § 103(a). Accordingly, the claim rejections under 35 U.S.C. 103(a) are *legally deficient on their face and, consequently, must be withdrawn*. Accordingly, withdrawal of the claim rejections under 35 U.S.C. § 103 is respectfully requested.

Respectfully submitted,



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